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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/672,126	09/27/2000	Gunther Hartmann	C1039/7044 (AWS)	6887

7590 12/18/2001

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EXAMINER

NGUYEN, QUANG

ART UNIT PAPER NUMBER

1632

DATE MAILED: 12/18/2001

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Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/672,126	<b>Applicant(s)</b> HARTMANN ET AL.	
	<b>Examiner</b> Quang Nguyen	<b>Art Unit</b> 1632	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-24,47,65,82,103,122,143,159,199 and 201-203 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-24,47,65,82,103,122,143,159,199 and 201-203 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                            | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____   |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)        | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ | 6) <input type="checkbox"/> Other: ____                                     |

## DETAILED ACTION

### *Election/Restrictions*

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-24, 65, 82, 103, 176, 199 and 202-203, drawn to methods comprise co-administering an effective amount of an isolated immunostimulatory nucleic acid; and a pharmaceutical composition comprising an isolated nucleic acid having a sequence selected from the group consisting of SEQ ID NO:2 to SEQ ID NO. 37, classified in class 514, subclass 44; class 424, subclass 85.7.
- II. Claims 47 and 122, drawn to *ex vivo* methods for treating a subject to activate interferon-producing cells of the subject or for enhancing efficacy of IFN-alpha in subject in need of such treatment, classified in class 424, subclass 93.21.
- III. Claims 143, 159 and 201, drawn to a method for supporting survival of natural interferon-producing cells or for stimulating isolated interferon-producing cells *in vitro*, said method comprising contacting interferon producing cells with an amount of immunostimulatory nucleic acid; and an isolated nucleic acid sequence having a sequence selected from the group consisting of SEQ ID NO:2 to SEQ ID NO:37, classified in class 435, subclass 455; class 536, subclass 23.1.

Should Applicant elect the invention of Group I or Group III, Applicant is further required under 35 U.S.C. 121 to elect any 10 SEQ ID NOs. This is not a species election requirement, because there is no common core structure among SEQ ID NO:2 to SEQ ID NO:37. Additionally, because of limited resources from the US PTO to conduct the computer search of the claimed SEQ ID NOs, an undue burden would be needed to search and examine all of the claimed SEQ ID NOs, restriction for examination purposes as indicated is proper. Claims 1-24, 65, 82, 103, 176, 199, 202-203 and claims 143, 159, 201 link the inventions of SEQ ID NO:2 to SEQ ID NO:37. The restriction requirement between the linked inventions is subject to the non-allowance of the linking claim(s), claims 1-24, 65, 82, 103, 176, 199, 202-203 and claims 143, 159, 201. Upon the allowance of the linking claims, the restriction requirement as to the linked invention shall be withdrawn and any claim(s) depending from or otherwise including all the limitations of the allowable linking claim(s) will be entitled to examination in the instant application. Applicant(s) are advised that if any such claim(s) depending from or including all the limitations of the allowable linking claim(s) is/are presented in a continuation or divisional application, the claims or the continuation or divisional application may be subject to provisional statutory and/or non-statutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 USC 121 are no longer applicable. See *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-132 (CCPA 1971). See also MPEP 804.01.

The inventions are distinct, each from the other because of the following reasons:

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Although there are no provisions under the section for "Relationship of Inventions" in M.P.E.P. § 806.05 for inventive groups that are directed to different methods, restriction is deemed to be proper because these methods appear to constitute patentably distinct inventions for the following reasons: The methods in Groups I-III differ in method steps involved, different end-results (for example, therapeutic results are not required for the method of Group III), and different technical considerations for achieving the end-results. Therefore, a search and examination for all inventions in one patent application would result in an undue burden.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, separate search requirements, and different classification, restriction for examination purposes as indicated is proper.

Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17 (h).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quang Nguyen, Ph.D., whose telephone number is (703) 308-8339.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's mentor, Dave Nguyen, may be reached at (703) 305-2024, or SPE, Karen Hauda, at (703) 305-6608.

Any inquiry of a general nature or relating to the status of this application should be directed to Patent Analyst, Patsy Zimmerman, whose telephone number is (703) 308-0009.

**To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 1632.**

Quang Nguyen, Ph.D.

A handwritten signature in black ink, appearing to read "Dave", with a stylized flourish extending from the end.

**DAVE T. NGUYEN  
PRIMARY EXAMINER**